

### Remarks

The Final Office Action dated June 16, 2004 has been received and its contents carefully noted. In response thereto, Applicants have amended some of the existing claims in an effort to place the application in condition for allowance. Reconsideration of the rejection of the claims is respectfully requested in view of the foregoing amendments and the following remarks offered on the cited prior art, and it is trusted that they will be persuasive in bringing about a favorable reconsideration and allowance of the claims.

Independent claim 1 is amended to more clearly define the claim element "a unique information which identifies the user station" to "a unique identification information in the form of an identification code which identifies the particular user station equipment sending the order." Support is found in the specification and figures at least at page 11, lines 21-25 and page 12, line 25 to page 13, line 5 and elsewhere in the specification.

Independent claim 9 is amended to more clearly define "identifying the user station via a code specific to the user station" to "identifying the user station via an information code specific to the user station equipment ordering the application." Support is found in the specification and figures at least at page 14, lines 15-19 and page 14, line 20 to page 15, line 8 and elsewhere in the specification.

Independent claim 13 is amended to more clearly define "unique identification code" to wherein "said unique identification code identifies said user station equipment." Support is found in the specification and figures at least at page 11, lines 16-25 and page 12, lines 18-22 and elsewhere in the specification.

No new matter is added to the claims and no new issues are presented for consideration by way of the amendments. The amendments are fully supported by the specification and drawing figures and are of a clarifying nature only to more clearly define the existing claim elements presented. Accordingly, Applicants respectfully request entry of the amendments.

### Drawings

Applicants note the Examiner has indicated the formal drawings filed on March 25, 2004 are accepted.

Claim Rejections 35 U.S.C. §102 and §103

Turning now to the rejections under 35 U.S.C. §102 and §103, claims 1-5, 8-10, 12, 13-16 have been rejected as being completely shown by Rose (European Patent Application No. EP 0778,512 A2).

To reject claims 6 and 7, the teachings of Pashley et al. (US Patent No. 5,978,833) are added to the teachings of Rose.

Claim 11 has been rejected on the grounds of alleged obviousness by combining the teachings of Pashley et al. with the teachings of Rose as an obvious motivation.

The Examiner maintains the rejection of the claims of the application relying on the reasoning of the previous Office Action dated December 23, 2003, Paper No. 8. Applicants respectfully disagree with these rejections for the following cogent reasons.

European Patent Application No. EP 0778,512 A2

The European Patent Application No. EP 0778,512 A2 (Rose) discloses a “try and buy” system for managing the distribution of licensed application programs and components including trial versions that automatically expire at the expiration of predetermined trial usage privileges (column 1, lines 4-8). One goal of Rose's system is to prevent users from disseminating executable copies of application programs to other end users because those other end users have not necessarily agreed to the licensing terms of the program's owner (column 1, lines 44-48).

Another goal of Rose is to limit generation of an executable version of an application program to a user only when the user is entitled to execute the application program at the time execution is attempted by the user (column 2, lines 10-13).

Rose accomplishes these and other goals through the use of an affirmative action by a user to accept licensing terms of usage specific to an identified user regardless of the identity of the computer station from which the user attempts to access, download and execute the application program.

Rose teaches that each client computer 102 may have one or more users. The client computer has a memory which stores among other items an Application Builder Program 112 and Application Programs 117 which contain certain features (column 3, lines 34-36).

The certain features may optionally include a client License ID 103 embedded in the Application Builder 112 which License ID 103 may be used for access verification (column 3,

lines 47-49). The Application Builder 112 may also optionally include a pair of public and private keys 113 that are unique to the client computer (column 3, lines 50-52). The operation and usage of public and private keys to access, transmit and download files is well known to those skilled in the art and such use is commonly employed by users to ensure that only the receiving party can access the transmitted information. The information is encrypted and transmitted to the receiving party using the public key of the receiving party. The information can only be accessed and decrypted using the receiving party's private key.

The user selects an Application Program for trial use and the user is associated with a licensed version of the Application Builder which license may be pre-existing or allocated to the user during downloading of the trial version. In either event, the Application Builder is licensed to the user and, a license identifier is associated with that user (column 6, lines 14-22).

A user associated with one of the client computers 102 sends a request to the server 104 to access the trial version of the Application Program (Fig. 8, column 8, lines 27-29). Upon selecting the program, the user is prompted to accept the license terms. The acceptance is made by some affirmative action of the user before the selected program will be downloaded (column 8, lines 36-43).

The affirmative action may be entry of an identifying name or retype of a verification code such as the user's license ID (column 8, lines 43-45). The access privilege also requires explicit user acceptance of the licensing terms through user information such as the identity of the user (column 8, lines 3-7).

When the access conditions are satisfied, the server generates a transmission format version of the Application Program for a particular user and contains user identification information including a licensee identification code (column 9, lines 15-25). The application program now resides in the client computer and will only execute after verification that the date is still within the trial period by using the Application Builder's private key 113 and the server's public key 187 to retrieve control information that compares the license ID 184 in the application program with the Application Builder license ID and the corresponding termination dates. Once verified that the date is within the trial period, the Application Program is prepared for execution (column 9, line 39 to column 10, line 7).

The information used for identification in the Rose system at the client computer is the user identity, Application Builder private key, in conjunction with the Server's public key and optionally a license ID in the Application Builder Program.

Accordingly, a user in the Rose system can select and download an application program from any client computer because the access and program execution control information is associated with the user identification and optionally license ID information embedded in the Application Builder Program.

### Applicants' Invention

Applicants' invention as disclosed and claimed provides a method and system for downloading copy protected dedicated applications to a user station 10 such as a mobile station from an application source 30 wherein the executable program is limited or dedicated for use and operation to the user station equipment from which the application program is ordered. Each user station equipment or hardware has a unique identification code 12 which is included with the order (Fig. 1, page 12, lines 25-29). The unique equipment identification code 12 of the user station 10 may be in different formats including IMEI, ESN, SIM and the equipment identification code identifying the ordering station 10 is embedded in the application program during the ordering process (page 13, lines 1-5).

During the download process, the application is dedicated, i.e., specifically configured, to only be useable by the specific user station which is identifiable to the application source via the equipment identification code 12 (page 7, lines 1-4). As clearly described and disclosed in the specification, the copy protected dedicated application will only function or operate on the specific mobile station 10 whose identification code matches the hardware identification code of the ordering station embedded in the application program because the downloaded application program now residing in the mobile station will check and match the identification code given to it (i.e., the downloaded application program) at the time the order was placed to the code in the application program when the application program is executed (page 13, lines 25-28).

In other words, the copy protected dedicated application can only be executed in the mobile station placing the original order. The copy protected dedicated application cannot be executed on a different mobile station from the ordering mobile station because the mobile

station identification code would be different from the identification code of the mobile station placing the order even if the different mobile stations are operated by the same user.

As described in the specification page 11, line 15 through page 12, line 22, the mobile station 10 signals the server 30 via the network 20 to connect to the server 30 and the server returns a signal to the mobile station 10 that a connection is open. The mobile station 10 sends an order for a new application and provides its identification information in the form of an identification code 12 unique to the mobile station as represented by the reference numeral 3. The identification code 12 is that of the equipment of the specific mobile station 10 placing the order. The server 30 then begins a dedication process 4 of the application to create a dedicated application 40 which includes the identification code 12 of the mobile station 10. The dedicated application 40 is automatically downloaded to the mobile station 10 from the server 30 in an executable format as indicated by the reference numeral 5.

The dedicated application 40 will only function with the specific mobile station 10 which provides a matching identification code 12 specific to the mobile station 10. The dedicated application 40 is not useful if illegally copied to a different mobile station because the different mobile station does not have the identification code 12 of the mobile station 10 placing the order. In other words, the mobile station 10 is able to order and download or receive a newly created dedicated application 40 directly from the server 30 by providing unique identification information specific to the hardware of the mobile station and which information is incorporated into the newly created dedicated application 40. Therefore, in the present application as disclosed and claimed, a dedicated application can be accessed and downloaded but it cannot be run in the terminal or mobile station if the device identification is not the same as the ordering device identification used when the dedicated application was created (page 11, line 29 to page 12, line 3).

In contrast to Applicants' invention, there is no teaching, disclosure or suggestion in Rose that an actual hardware device is identified or has an equipment identification code embedded in the application program to manage the distribution of the licensed application program stored on server. Rose relies upon the affirmative action of a user to either accept a license to download a selected program and matching of the user's license with a client ID to download a selected program.

In the Rose system, a user could go to different client computers, and input his client ID along with the required license information to download the program since the match is made between the client ID and presumably a registered license for that client. Applicants submit there is no motivation or reason to modify Rose to provide a specific equipment hardware identification code nor is there any teaching, suggestion or disclosure in Rose to do so.

Further, the lack of an equipment hardware identification code in Rose makes it impossible to embed the ordering mobile station identification code in the application program ordered from the server as required in Applicants' invention.

In addition, there is no suggestion, disclosure or teaching in Rose that requires the matching of the unique equipment identification code of the client computer to the embedded identification code of the ordering mobile station in the application program to allow execution of the downloaded files of the dedicated application.

Accordingly, Applicants submit that Rose is deficient with respect to paragraph A of claim 1 by failing to disclose, teach or suggest the order comprising at least a unique identification information in the form of an identification code which identifies the particular user station equipment sending the order. Rose identifies the user not the client computer.

Rose is further is deficient with respect to paragraph B of claim 1 by failing to teach, disclose or suggest preparing a dedicated application by configuring a general application accessible to the application source to include the unique identification specific to the user station equipment identification code. Rose does not embed the client computer hardware identification code in the application program as Rose lacks such an equipment identification code to identify the particular client computer ordering the application.

Rose therefore lacks a unique and essential claim element feature of the invention as disclosed and claimed. Claims 2-8 are dependent directly or indirectly upon independent claim 1 and it is submitted that these claims are likewise allowable for similar reasons and further for limitations clearly set forth therein.

With regard to claim 9, Rose is deficient with respect to at least the step of ordering an application from the distributor including automatically identifying the user station via an information code specific to the user station equipment ordering the application and further with respect to the step of automatically replacing the variable with the information code specific to the user station equipment ordering the application to make the application a dedicated

application which is copy protected and which will only run on the user station with a matching equipment information code. As explained above, Rose does not teach, suggest or disclose a unique equipment identification code specific to a client computer and therefore cannot replace the variable in the application with the information code specific to the user station equipment ordering the application. At best, Rose can only insert a License ID provided by the user. A user in Rose can access and execute the application program from any client computer regardless of the hardware identity of the client computer even if one were present as suggested by the Examiner.

Rose does not teach, disclose or suggest creating dedicated applications from a "template" application (that is, a general application) in which a unique identification information code which identifies the user station equipment is used to make the general application a dedicated application for that particular mobile station only. Rose does not teach, suggest or disclose the creation of a dedicated application using the equipment identification code of a client computer to limit the execution of the application program to only that client computer because a user in Rose can access, download and execute the application program from any client computer.

Claims 10-12 are dependent upon independent claim 9 and are likewise distinguishable for similar reasons and further for limitations clearly set forth therein.

With regard to claim 13, Rose does not teach, disclose or suggest a system for ordering and downloading copy protected dedicated applications to a user station from an application source wherein the user station signals at least one unique identification code identifying the user station equipment when placing an order for the dedicated application and substituting the equipment identification code for the variable set by the manufacturer of the application. Therefore Rose is deficient with respect to a unique and essential claim element feature recited in paragraph A and paragraph C of claim 13. Further, Rose lacks an essential claim element in that the application source in Rose is not responsive to the user station for receiving and checking the user station equipment identification code of the user station for authentication purposes. As explained above, Rose does not teach, suggest or disclose a unique equipment identification code for a client computer and therefore the identification code cannot be checked as is required in Applicants' invention as disclosed and claimed.

Likewise, Rose does not teach, disclose or suggest an application including a variable set by a manufacturer of the application which application is responsive to a command for substituting a user station equipment identification code for the variable to create a dedicated application nor does Rose disclose comparing and matching the user station equipment identification code of the application to the user station equipment identification code of the user station. Rose does not teach, suggest or disclose a unique equipment identification code nor is any motivation present in Rose to provide such an equipment information code.

Claims 14-16 are dependent upon independent claim 13 and it is submitted that these claims are likewise distinguishable for similar reasons and further for limitations clearly set forth therein.

With regard to claims 6, 7 and 11, the addition of the teachings of Pashley et al. do not overcome the fundamental deficiencies of Rose nor is there any teaching in Pashley that would lead one skilled in the art to modify Rose to arrive at Applicants' invention as disclosed and claimed.

### Summary

Applicants submit that Rose does not anticipate Applicants' invention as disclosed and claimed for at least the reason that Rose does not teach, suggest or disclose the essential element of a unique identification information in the form of an identification code which identifies the particular user station equipment sending the application order to the application source.

Applicants further submit that Rose does not anticipate Applicants' invention as disclosed and claimed for at least the additional reason that Rose does not teach, suggest or disclose preparing a dedicated application to include the unique identification information specific to the user station equipment identification code of the user station ordering the application from the application source. The application program of Rose does not include unique equipment identification information specific to the user station because Rose does not have such information. The user in Rose can access and execute the application program from any client computer based solely on the license information provided by the user.

Applicants submit that the essential claim elements of the independent claims 1, 9 and 13 are not taught, suggested or disclosed by the Rose European Patent application and respectfully



request withdrawal of the rejection of claims 1-5, 8-10, 12, 13-16 under 35 U.S.C. §102 and §103.

Applicants submit the teachings of Pashley et al. added to the teachings of Rose fail to likewise teach, suggest or disclose the essential elements of claims 1, 9 and 13 from which claims 6, 7 and 11 depend directly or indirectly, and therefore respectfully request withdrawal of the rejection of claims 6, 7 and 13 under 35 U.S.C. §103.

In addition to the above, the various applied prior art references offer no teaching which would prompt the artisan of ordinary skill to make the combinations/modifications proposed by the Examiner. In fact, it is only when the Examiner looks to Applicants' own disclosure that he can allege obviousness by choosing bits and pieces of the prior art references and then combining these bits and pieces together based on alleged obviousness. Without a teaching (other than Applicants' own teaching) to prompt the combinations/modifications, the rejections are merely improper hindsight reconstruction of Applicants' own invention using Applicants' own disclosure. The Court of Appeals for the Federal Circuit has steadfastly criticized such modification. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). See also, e.g., In re Laskowski, 871 F.2d 115, 10 USPQ 2d 1397 (Fed. Cir. 1989); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); In re Grabiak, 769 F.2d 729, 731, 226 USPQ 870, 872 (Fed. Cir. 1985); In re Sernaker, 701 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983).

Accordingly, it is submitted that the present invention as claimed is readily distinguishable from the prior art references for the reasons indicated. Applicants' invention is not disclosed by any of the prior art and there is no fair basis for alleging that Applicants' invention is obvious in regard to such prior art. If the invention was obvious, it would have been adopted before in view of its advantages.

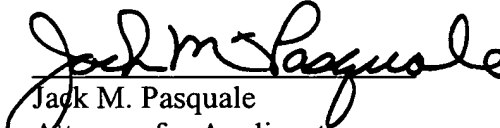
In sum, it is submitted that the present invention as claimed is readily distinguishable from the applied references for the reasons indicated. Applicants' invention is not disclosed by the applied references and there is no fair basis for alleging that Applicants' invention is obvious in regard to them. If the invention was obvious, it would have been adopted before in view of its advantages.

**Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that all the claims are allowable and early favorable action is earnestly solicited. The Examiner is invited to call Applicants' attorney if any questions remain following review of this response.

Respectfully submitted,

Date: August 11, 2004

  
Jack M. Pasquale  
Attorney for Applicants  
Registration No. 31,052

WARE, FRESSOLA, VAN DER SLUYS  
& ADOLPHSON LLP  
Bradford Green, Building Five  
755 Main Street, P.O. Box 224  
Monroe, CT 06468  
Telephone (203) 261-1234  
Facsimile (203) 261-5676